

OFFICIAL

**FROMMER LAWRENCE & HAUG LLP** FAX RECEIVED

745 Fifth Avenue  
New York, New York 10151  
Telephone: (212) 588-0800  
Facsimile: (212) 588-0500  
E-mail: Firm@flhlaw.com

JUL 16 2003

GROUP 1600

**FACSIMILE COVER LETTER**

**To:** Examiner Robert W. Ramsuer  
**Firm:** USPTO  
**Facsimile:** 703-305-3592  
**From:** Thomas Kowalski  
**Date:** July 15, 2003  
**Re:** Response to Restriction Requirement  
USSN: 10/029,876  
Our Ref. No.: 454313-3183  
**Number of Pages:** 4  
(including cover page)

---

If you do not receive all pages or are unable to read the transmission, please call and ask for Michelle Ekanemesang (Ext. 2197).

---

**CONFIDENTIALITY NOTICE**

The documents accompanying this transmission contain confidential information intended for a specific individual and purpose. The information is private, and is legally protected by law. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or the taking of any action in reliance on the contents of this facsimile is strictly prohibited.

00132405

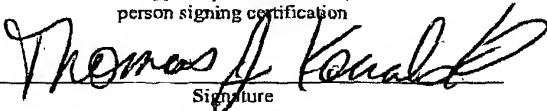
PATENT  
454313-3183**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Scot Kevin HUBER  
Serial No. : 10/029,876  
Filed : December 31, 2001  
For : INTERMEDIATES FOR PESTICIDAL COMPOSITION  
COMPRISING ENANTIOMERIC FORM OF FIPRONIL  
Examiner : Robert W. RAMSUER  
Art Unit : 1626  
Confirmation No : 4296

745 Fifth Avenue  
New York, New York 10151**FACSIMILE**

I hereby certify that this paper is being facsimile transmitted to the  
Patent and Trademark Office on the date shown below.

Thomas J. Kowalski, Reg. No. 32,147

Type or print name of  
person signing certification

Signature

July 15, 2003

Date of Signature

**RESPONSE TO RESTRICTION REQUIREMENT AND  
REQUEST FOR EXTENSION OF TIME AND INTERVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed on January 15, 2003, Applicant elects with traverse Group II and the species corresponding to formula III-A/III-B of claim 10 wherein the organic radical E corresponds to Mosher's acid.

PATENT  
454313-3183**REQUEST FOR EXTENSION OF TIME**

A five-month extension of the term for reply, i.e., up to and including July 15, 2003, is requested. The Commissioner is hereby authorized to charge the fee therefor and any additionally required fee occasioned by this paper, or credit any overpayment in such fees, to Deposit Account No. 50-0320.

**REMARKS**

In response to the Restriction Requirement mailed on January 15, 2003, Applicant elects Group II, which corresponds to claims 10-14. In addition, Applicant elects the species corresponding to formula III-A/III-B of claim 10 wherein the organic radical E corresponds to Mosher's acid—that is, wherein the EC(O)- group of formula III-A/III-B of claim 10 is  $\alpha$ -methoxy- $\alpha$ -trifluoromethylphenyl acetyl. Of the elected claims, claims 10, 11, 13, and 14 read on the elected species. The Restriction Requirement is traversed, and its modification is requested in view of the following remarks.

The present application relates to Applicant's discovery that the S enantiomer of the insecticide fipronil is more insecticidal and less toxic than the R enantiomer. The claims of the present application are drawn to diastereomeric fipronil derivatives and the use of the derivatives for separating fipronil enantiomers. The Restriction Requirement divided the claims into three Groups:

- Group I, corresponding to claims 1-9, is drawn to drawn to diastereomeric derivatives of fipronil used in the processes of Groups II and III;
- Group II, corresponding to claims 10-14, is drawn to processes for preparing compositions comprising (S)-fipronil involving the diastereomeric derivatives of Group I;
- Group III, corresponding to claims 15-18, is drawn to processes for preparing compositions comprising (S)-fipronil involving the diastereomeric derivatives of Group I.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP§803. Second, searching the additional invention must consti-

PATENT  
454313-3183

tute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions." *Id.*

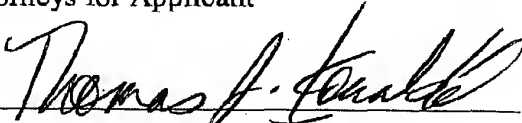
The Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Searching and examination of the process claims of Group II would be expected to significantly overlap with searching and examination of the related process claims of Group III and with the compound claims of Group I.

In view of the foregoing, the present application represents a web of knowledge and continuity of effort that merits examination in a single application. Accordingly, reconsideration and modification of this election requirement and an early action on the merits is earnestly solicited.

#### REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, a telephonic interview is respectfully requested prior to issuance of any paper other than a Notice of Allowance; and the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner therefor.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicant

By:   
Thomas J. Kowalski  
Reg. No. 32,147  
(212) 588-0800